

Serial No.: 09/520,580
In reply to Office Action mailed: December 4, 2003
Page 6 of 8

Remarks/Arguments

Claims 9, 18 and 20-30 are pending in this application. Claims 1-8, 10-17, and 19 have been canceled. The Examiner has indicated that claims 9 and 18 are allowable over the art of record. No new matter has been added to the prosecution of this application. For at least the reasons stated below, Applicants assert that all claims are in condition for allowance.

1. Information Disclosure Statement

On page two of the Final Office Action the Examiner claims the Dayco statement filed by Applicants on December 1, 2003 is improper because the serial numbers of the related applications are not listed on the filing. Applicants direct the Examiner's attention to page two of the Dayco statement, in which in column 1 of the table indicates the serial numbers of the related applications are listed. Therefore, Applicants believe the Dayco statement should be acceptable.

2. 35 U.S.C. § 112 Rejections

Claims 20-30 are rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. Specifically, the Final Office Action alleges that the specification fails to describe the subject matter claimed in claims 20 and 30, the "plurality of nontemporal preferences." Applicants assert that the specification adequately describes the claim limitation "plurality of nontemporal preferences." As such, applicants submit that the rejection based upon 35 U.S.C. § 112 first paragraph is inappropriate and should be withdrawn. It is noted that the concept of "nontemporal preferences" may be somewhat confusing when discussed in the context of goal setting. Typically, the setting of goals inherently includes some component of time (e.g. a selected time period or a specific date for completion). Goal setting can also involve nontemporal components however, especially when goals include several components. The present invention, as set forth in claims 20-30, recognizes this fact.

Applicants assert that the specification adequately describes the claim limitation. An objective standard is applied, such that one considers whether "the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed."

Serial No.: 09/520,580
In reply to Office Action mailed: December 4, 2003
Page 7 of 8

MPEP § 2163.02 ¶ 1 (quoting *In re Gostell*, 872 F.2d 1008, 1012, 10 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1989)). In this application, Applicants clearly described nontemporal preferences which may be selected in relation to a temporal preference, such that a person of ordinary skill in the art could recognize that claims 20 and 30 as what is invented. See Specification p. 28, ll. 6-11 (describing quality as a non-temporal preference); p. 5, ll. 13-18 (describing non-temporal preference of designating priority of completion); p. 31, ll. 14-17 (describing priority as a non-temporal preference). In the context of setting financial goals, choices related to monetary values, interest rates, etc. also involve nontemporal preferences. Based upon this disclosure in the specification, one of ordinary skill in the art would easily recognize other non-temporal preferences that may be encompassed by this invention. On this basis, a rejection claiming the specification does not describe the claimed invention is improper and should be withdrawn.

3. 35 U.S.C. § 102 Rejections

Claims 20-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ferguson et al., U.S. Patent No. 6,064,984 (hereinafter "*Ferguson*"). Applicants oppose this rejection. Applicants assert that *Ferguson* is inapplicable to the presently presented claims because the art is being applied to defeat an "interpretation" of the claims that never existed nor was ever presented by Applicants.

In the final office action, an assumption is made regarding the phrase "plurality of nontemporal preferences." This assumption is simply incorrect, and thus the rejection is inappropriate. Equated are the phrases "plurality of nontemporal preferences" and "a plurality of preferences," upon which all pending claims are rejected based upon this interpretation with the *Ferguson* art. See Final Office Action, at 2-3. Neither the plain meaning of the phrase or the specification lend such an interpretation. Consequently, the rejection is inappropriate.

When interpreting claims, "the claims must be interpreted as broadly as their terms reasonably allow." MPEP § 2111.01 ¶ 1 (citing *In re American Academy of Science Tech Center*, ___ F.3d ___, 2004 WL 1067528 (Fed. Cir. May 13, 2004)). "This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification." *Id.* (citing *In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989)). In this application, Applicants do not uniquely define the

Serial No.: 09/520,580
In reply to Office Action mailed: December 4, 2003
Page 8 of 8

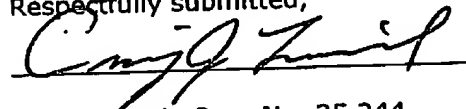
term "nontemporal preference" in the specification, instead intending the ordinary meaning of the words be used. "Nontemporal preferences" would be those preferences not having a temporal component. The equation of nontemporal preferences to temporal preferences and the resulting rejection of the claims based upon *Ferguson* is wholly inappropriate as no reasoning has been provided for doing so nor is there an indication in the specification where Applicants have uniquely defined the term "nontemporal preference" in the manner relied upon in the Final Office Action. Therefore, Applicants request that a response be provided to Applicants' proposed claims as written, or the rejection be withdrawn.

After giving the claims their proper interpretation, it is clear that *Ferguson* does not anticipate the invention of claims 20-30. *Ferguson* only employs temporal preferences that may be adjusted by the user of the invention, but does not employ nontemporal preferences. See *Ferguson* at Figs. 7A-7D, col. 9, l. 57 - col. 10, l. 6. Further, there are no suggestions regarding the consideration of nontemporal preferences in the specification. Thus, the rejection of claims 20-30 under 35 U.S.C. § 102(e) are inappropriate and applicants request that they be withdrawn.

4. Conclusion

Applicants submit that for at least the reasons stated above, all pending claims are allowable over the art of record and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7387. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees, including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-352901).

Respectfully submitted,



Craig Lefvick, Reg. No. 35,244
Customer No. 29838
OPPENHEIMER WOLFF & DONNELLY LLP
45 South Seventh Street, Ste. 3300
Minneapolis, MN 55402
Phone: (612) 607-7387
Fax: (612) 607-7100